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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
NGUYEN, THUY-VI THI	
ART UNIT	PAPER NUMBER
3689	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/692,974	REISMAN, RICHARD	
	Examiner	Art Unit	
	THUY-VI NGUYEN	3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 June 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-170* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *134-140; 155-170* is/are rejected.

7)☐ Claim(s) *156, 158, 162-169* is/are objected to.

8)☐ Claim(s) *1-133; 141-154* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *24 October 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *10/08/08;07/14/09*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. In response to the applicant's communication filed on 06/01/09, wherein applicant has elected with traverse Group III, claims (claims 134-140) and newly added claims 155-170). Applicant stated *"there is no undue burden for the Examiner to conduct a substantive search of the claims corresponding to Groups I-IV*" is noted. However, this is not persuasive because this is merely applicant's opinions without specific evidence/analysis of the rejections to indicate the groups of all claims in an application can be made without serious burden. The claims are not related to the same subject matter and have different scopes and have different modes of operations and it is a serious burden for the examiner to search these independent inventions which have different claim scopes. The inventions of groups I, II, III and IV are independent and distinct for the reason given above and there would be serious search and examination burden if restriction were not required.

DETAILED ACTION

2. Applicant's communication filed on 06/01/09 wherein:

Claims 1-170 are currently pending;

Claims 155-170 have been added.

Group III, claims (134-140) have been elected.

Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. **Claims** 134-140 (Method); 155-170 (Method) are reject under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a particular machine or apparatus, or (2) transform a particular article to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972). If neither of these requirements is met by the claim, the method is not a patent eligible process under §101 and is non-statutory subject matter.

With respect to claims 134-140; 155-170**,** the method claims are:

(1) not tied to a particular machine or apparatus, nor

(2) transforms a particular article to a different state or thing.

With respect to 134-140; 155-170**,** the claim language does not transform the underlying subject matter and the process is not tied to another statutory class. For instance in claim 1, the process steps of "*marking available…; applying….; receiving….; offering….;"* is not tied to another statutory class, such as an apparatus, and thus, the claims are directed to nonstatutory subject matter.

Here claims fail to meet the above requirements since (1) there is not a sufficient tie to another statutory class (2) transformation to a particular article to a different state or thing, and thus is directed to nonstatutory subject matter.

Claim Objections

5. Dependent claims 156, 158, 162-169 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

1) Claim 155 and 157 step (c) calls for "*receiving from one or more of said users, rating data corresponding to one or more posted items*". In other word, this indicates that the information/data/items have been received. However, dep. claims 156 and 158 recites "*… considering the reputation levels associated with the one ore more users from which the rating data was received*" is not further limit the "receiving rating data" step of claim 155 and 157. Once the information or data is already received, how could the information/data further limit the "considering reputation levels of users"?

Therefore, claims 156 does not further limit claim 155; and claim 158 does not further limit claim 157 for the reasons above.

Dep. claims 162-169 are dependent on claim 158, therefore, they are also objected as the dep. claim 158.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 155-156, 157-170 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) Dep. Claim 155, step 1 recites "*making available a process of said system enabling users of said collaborative support to post items to be accessible to* <u>*all users*</u> (users 1, 2, 3)", and step 2 recites "*receiving, from one or more of said users (users 1,2,3 from step 1) rating data corresponding to one or more posted items*" is unclear. It appears that the users (1, 2, 3) of steps 1 and 2 are the same. However, it doesn't seem to be right when the same users (1, 2, 3) post the items as well as rating the items by themselves.

2) Dep. Claim 155, step 1 recites "making available a process of said system...", it is not clear what type of process to enable the users to post items?

3) Dep. Claim 155, step 3 recites "offering filtered viewing of said items" is vague and indefinite because it is not clear what items have been filtered? and how the viewing of items is filtered? It appears for the term "filtered viewing" in the limitation is lack of antecedence and basis because there is no "filtering" step in the limitation.

4) Dep. Claim 155, recites the limitation "the filtering", there is insufficient antecedent basis for this limitation in the claim.

5) Independent claim 157 is rejected for the same reason sets forth dep. claim 155 above.

6) Dep. claim 159, recites "there are multiple alternative algorithms for said filtering and the choice of an algorithm to be used for a given request for a filtered view may be selected by a participant" is vague and indefinite. It is not clear, how the alternative algorithms are performed for the filtering? And how the algorithm is being used for a given request?

7) Dep. claim 159 recites “a participant”, what is the different between "a participant and the users from claims 157?

8) Dep. claim 159 recites “said filtering”, and “the choice of an algorithm”, there is insufficient antecedent basis for this limitation in the claim.

9) Dep. claim 160, recites “wherein the multiple alternative algorithms may themselves be subject to rating by participants" is vague and indefinite because it is not clear what this phrase is encompassed. What does that mean by reciting "may themselves be subject to rating by participants?

10) Dep. claim 162 recites the term “the consideration of reputation factors”, is this phrase similar to the phrase “the reputation levels" recites in claim 158?

11) Dep. claim 163, recites “the degree..”, there is insufficient antecedent basis for this limitation in the claim.

12) Dep. claim 167, recites “a participant”, is this participant different than a participant in the dep. claim 159?

13) Dep. claim 169 recites “a participant’s reputation”, is this participant's reputation is different than a participant's reputation in dep. claim 167?

14) Dep. claim 170, recites “the population of participants of the community", and “the respective participant’s membership”, there is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. **Claims 134-140** are rejected under 35 U.S.C. 102(e) as being anticipated by GABRICK ET AL (US 2004/0073443).

As for independent claim 1, GABRICK ET AL disclose a method of operating a collaborative support system {see figure 13, and at least pars. 0167-0168; 0172} , comprising:

making available a plurality of ranking/analysis alternatives or plurality of tools for a collaborative support process of said system;

{see at least par. 0056-0059; 0193-0203 discloses the plurality of alternative tools such as *ranking/analysis module, rating/analysis, collaboration , rating factors, comparative analysis* },

applying one or more support processes active within said system to select for use of one or more said alternatives

{see pars. 0194 where the selection of one of the alternative tools is applied to gather financial information about various innovations that would be beneficial to a company. Also, the ranking module would be considered an active support process once the user selects the ranking module}.

As for dep. claims 135-137 which discloses the active support processes or parameters includes a rating process, ranking process, a decision making process/decision factors, this is taught in GABRICK ET AL {see pars. 0193-0203}.

As for dep. claims 138-140 which discloses the collaborative process having alternatives are rating process, ranking process, and decision making process/decision factors, this is taught in GABRICK ET AL {see pars. 0193-0203}.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims **155-170** are rejected under 35 U.S.C. 103(a) as being unpatentable over GABRICK ET AL.

As for dep. claim 155, GABRICK ET AL disclose:

making available a process of said system enabling users of said collaborative support system to post items/ideas/innovation to be accessible to all users;

{see abstract, figure 13-14; at least pars. 0033-0034; 0038; 0053; 0061; 0088; 0168-0172 disclose the collaboration or sharing system where "ideas are submitted by the users" and are shared to other};

receiving from one or more of said users, rating data corresponding to one or more posted items;

{see at least pars. 0196-0200 discloses the rating about the ideas or documents or innovations}

GABRICK ET AL discloses the claimed invention as stated above. GABRICK ET AL further discloses the concept of filtering information remove unnecessary/undesired data/information due to too much information. For example figure 17, at least pars. 0032, 0297, 0468, 0641, 0678, 0739, 0870, 1099) shows the ideas, documents or innovations can be, filtered, and sorted by multiple criteria e.g. a positive filter results are place into a file for filtered viewing of said items or data of (ideas, innovations, documents, the filtering taking use. However, GABRICK ET AL does not explicitly disclose the filtering taking into account the received rating data, or the filtering is based on the rating data. It would have been obvious to one of ordinary skill in the art to apply the same filtering concept to the viewing in order to show only the desired rated viewing or to retrieve only the list of information/data as the user's specific filters.

As for the objected dep. claim 156, which discloses the reputation levels or trusted sources or peers group, or IP counsel which are considered as groups of

people who are proficient in the field of items/ideas or innovations to rate or rank the posted items submit from the users, this is taught in GABRICK ET AL, par. 0056-0057.

As for independent claim 157, basically this independent claim has the similar limitations as rejected dep. claim 155. Therefore, it is rejected for the same reason sets forth the dep. claim 155 as stated above.

As for the objected dep. claims 158, basically this independent claim has the similar limitations as rejected dep. claim 156. Therefore, it is rejected for the same reason sets forth the dep. claim 156 as stated above.

As for dep. claim 159, which discloses the user or participant may be select different choices of filtering to be used for the viewing. Note: The term "maybe" is interpreted as "may" and "may not" or "being optional". The examiner is taken the "may not" position or "optional", thus the phrase "maybe" does not have any patentable weight. Furthermore, GABRICK ET AL discloses the filtering concept in pars. 0468, 0641, 0678, 0739, 0870, 1099.

As for dep. claim 160, which discloses the multiple alternative algorithms may themselves be subject to rating by participants. Note: The term "may" is interpreted as "may" and "may not" or "being optional". The examiner is taken the "may not" position or "optional", thus the phrase "maybe" does not have any patentable weight.

As for the dep. claim 161, which discloses the filtered viewing comprising the information or data value such as ranking, applying a cut off threshold algorithm, and rating value. This data/information have been determined to be non-functional descriptive material (NFDM), thus having no patentable weight and does not need to be

taught by the prior art. Nonfunctional descriptive material can not render nonobvious an invention that would have other wise been obvious. In re Gulack, 703 F. 2d 1381, 1385, 217 USPQ 401, 40-4 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability. See MPEP 2106.01. Furthermore, GABRICK ET AL discloses the rating and ranking value, and points/scores as shown on pars. 0193-0204, 0379, 0435-0439; figures 14, 21, 23 and 34.

As for the objected dep. claims 162 -163, which discloses using the weighting factors to weight the user rating of an item, this is fairly taught in GABRICK ET AL, at least pars. 0199, 0541-0549.

As for the objected dep. claim 164, which discloses the weightings are based on the respective reputation within a domain or within a same company or same field associated with the item, this is fairly taught in GABRICK ET AL, at least figures 36-38; pars.0541-0549.

As for the objected dep. claims 165-166, which discloses the participants or users are rating the items/information/data/innovations each other, this is fairly taught in GABRICK ET AL, at least pars. 0197-0202; 0541-0549.

As for the objected dep. claim 167, which discloses different type of level or class that item being rated, such as rating by a participant, item that is any other class of item, this is fairly taught in GABRICK ET AL, pars. 0197-0202.

As for the objected dep. claim 168, which discloses a participant's rating of an item maybe associated with a participant specified confidence level representing the

participant's level of confidence in the rating. Note :The term "maybe" is interpreted as "may" and "may not" or "being optional". The examiner is taken the "may not" position or "optional", thus the phrase "maybe" does not have any patentable weight. Furthermore, GABRICK ET AL discloses different confidence level of rating in pars. 0197-0202, figures 21, 3.

As for the objected dep. claim 169, which discloses the lower dependence on ratings given lower confidence by the user than on ratings given higher confidence, this is fairly taught in GABRICK ET AL, pars. 0197-0202, figures 21, 3.

As for the objected dep. claim 170, which discloses the population of participants of the community may be divided into multiple sub-communities, an the filtered viewing further takes into account the level of the respective participant's membership in a specified sub-community. Note: The term "may be" is interpreted as "may" and "may not" or "being optional". The examiner is taken the "may not" position or "optional", thus the phrase "maybe" does not have any patentable weight.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thuy-Vi Nguyen whose telephone number is 571-270-1614. The examiner can normally be reached on Monday through Thursday from 8:30 A.M to 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./

Examiner, Art Unit 3689

/Tan Dean D. Nguyen/
Primary Examiner, Art Unit 3689